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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

AXEL SCHULTE

Serial No.: **09/601,280**

Filed: **July 31, 2000**

For: **FLOOR CARPET INSTALLING
SYSTEM**

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Art Unit: **1771**

Examiner: **C. A. JUSKA**

**PETITION UNDER 37 C.F.R. § 1.181 FOR
(1) ENTRY OF SUBSTITUTE SPECIFICATION, AND
(2) CONSIDERATION OF DECEMBER 9, 2003 BRIEF ON APPEAL**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.181, Applicants request the Commissioner of Patents and Trademarks to invoke supervisory authority and require consideration of the PCT modified sheets and substitute specification, and consideration of the Brief on Appeal filed December 9, 2003 in connection with the above-identified application.

No fee for this Petition is believed to be necessary. However, the Commissioner is hereby authorized to charge any fees necessary for this Petition to deposit Account No. 18-2220.

This Petition is filed in the Notification of Non-Compliance with 37 C.F.R. 1.192(c) dated September 22, 2004 which requires a new brief and states:

The Brief is non-compliant because it refers to the substitute specification which is being denied entry due to new mater contained therein. The substitute specification

was previously denied entry for lack of a proper marked up version. Note the Final Rejection of 03/19/03, section 2 and Rule 1.125(c), which states the marked up copy must show changes relative to the immediate prior version of the specification on record. The substitute specification mailed 03/09/04 in response to the Notice of Non-Compliance mailed 03/01/04, was accepted, but not actually entered, at that time by the examiner despite the lack of a proper marked up version. Upon deciphering the marked up copy of the specification, it has been determined that said substitute specification contains new matter. For example, the subject matter at page 3, lines 3-5 and the first paragraph of page 4 is not supported by the original disclosure of the present application. As such, it cannot be entered into the application as a replacement disclosure. Hence, the Appeal Brief is still non-compliant because it refers to the non-entered substitute specification.

However, the substitute specification should be considered since it is supported by the drawings and the International application (including the modified sheets) and does not include "new matter". If the substitute specification is entered, the basis for objecting to the Brief on Appeal is obviated.

Even if "new matter" is to be raised, such should be raised as a new ground of objection and/or rejection, and considered on appeal. Such is not a valid basis for objecting to the substitute specification at this late stage of the prosecution of this application.

Background

This application was filed as the U.S. national phase of PCT/EP98/06930 on July 21, 2000. The application was filed with the International application, as published, along with the annexes (modified sheets) to the International Preliminary Examination Report. English language translations of both the published application and of the annexes were submitted. A September 11, 2000 Notification of Acceptance of Application acknowledges receipt of the U.S. national phase documents on July 21, 2000 along with the translation of the International application. However, such notification does not indicate whether the annexes were received and/or entered.

The July 5, 2002 Office Action rejects the claims on various grounds. However, no specific comment is presented regarding the modified sheets.

A January 6, 2003 Amendment was filed submitting a new set of claims and a substitute specification. The submission of a substitute specification was supported by a marked-up copy of the original application, adding the subject matter of the modified sheets and various other changes made to the application which are indicated by handwritten deletions and additions.

In the March 19, 2003 Office Action, the substitute specification is not entered "due to the lack of a proper marked-up version". Although the Examiner stated "the marked-up version is incomprehensible", a very similar marked-up version was submitted and accepted in co-pending application No. 09/601,279, which application has now matured into U.S. Patent No. 6,699,560. No objection to the substitute specification was raised at that time based on "new matter". Further, the final rejection does not mention that the PCT modified sheets have not been considered.

A June 19, 2003 Amendment was filed in response to the final rejection and provided an explanation as to the marked-up version. This explanation, which was also provided in the companion case, was found to be adequate to provide for entry of the substitute specification which also involved the addition of PCT modified sheets.

An Advisory Action sent by facsimile only on September 16, 2003 refused to enter the Amendment to the claims which were included in the June 19, 2003 Amendment. No comments were made regarding the possibility of new matter. No mention is made at all regarding the substitute specification and its supporting marked-up version, thereby implying that the substitute specification was now acceptable.

A second Amendment under C.F.R. §1.116 was filed on September 17, 2003 amending the claims to render moot certain issues as was previously agreed to with the Examiner. In response to this Amendment, a September 25, 2003 Advisory Action and an October 21, 2003 Advisory Action were sent. The October 25, 2003 Advisory Action appears to be similar to that sent by facsimile on September 16, 2003 and discussed above. The October 21, 2003 Advisory Action enters the Amendments for purposes of appeal, indicates that certain rejections have been overcome, but states that the application is still not in condition for allowance for basically the same reasons stated in the prior Advisory Action. Again, no mention of the substitute specification is included. The lack of any mention of any specification plus the indication that the proposed amendments have been entered further indicates that the Examiner had previously accepted the PCT modified sheets as well as the substitute specification incorporating those PCT modified sheets.

With the Brief on Appeal, a third Amendment under 37 C.F.R. § 1.116 was filed amending a portion of the substitute specification. A January 2, 2004 Advisory Action stated that for purposes of appeal, that Amendment "will be entered" (see paragraph 7).

A March 1, 2004 Notice of Non-Compliance with 37 C.F.R. 1.192(c) objected to the brief, contending for the first time that the substitute specification and the PCT modified sheets were not entered. A Response filed March 9, 2004 by facsimile confirmed a March 9, 2004 telephone interview with the Examiner and resubmitted the substituted specification with another marked-up version. Another Response filed by facsimile on March 26, 2004 resubmitted the December 9, 2003 Brief on Appeal as requested by the examiner and confirmed a March 25, 2004 telephone interview in which the Examiner withdrew the objection to the brief, accepting entry of the substitute specification.

Argument

The foregoing prosecution history clearly indicates that the substitute specification should and had been entered in the record, particularly when considered with the PCT modified sheets. MPEP § 1893.01(a)(3) specifically permits amending an application to incorporate PCT modified sheets, as here, when the modified sheets cannot be simply substituted for the original sheets. Moreover, the German language modified sheets can be substituted, even though the translations thereof cannot. The PCT modified sheets are not mentioned in the September 22, 2004 Notification. The denial of entry and consideration of the substitute specification is unfair and unreasonable in view of the circumstances described above. If a "new matter" issue is to be raised, prosecution should be re-opened therefor.

No reason has been provided in this prosecution history for the objection to the PCT modified sheets, and thus, no reasonable basis exists for denying entry of the substitute specification. The PCT modified sheets contain the disclosure alleged to constitute the "new matter."

Even if the Examiner considers that certain portions of the substitute specification raise new matter, such portions should have been specifically identified previously to enable Applicant to respond thereto and to allow consideration thereof on appeal.

Solely to prevent the application from becoming abandoned in view of the Notification before this Petition is decided, a Response is being concurrently filed submitting a Conditional Brief on Appeal containing strikethroughs through the portions of the Appeal Brief referring to the substitute specification.

Prompt and favorable action in response to this Petition is solicited.

Respectfully Submitted,



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